

R E M A R K S

- Claims 1 – 46 are pending in the present application.
- Claims 1, 34 to 36, 39 to 43, and 45 are independent.
- Claims 54 – 56 have been added herein. Claims 54 – 56 are each dependent from claim 1. Support for claims 54 – 56 may be found in the specification as found (*e.g.*, page 12, lines 21 – 29).

1. Allowed Claim

Applicants gratefully acknowledge Examiner's statement that claim 35 is allowed.

2. Section 102 Rejection of Claims**2(a). Claims 1 – 7, 9, 10, 12 – 30, 36 – 39, 41 – 43, 45 and 46**

Claims 1 – 7, 9, 10, 12 – 30, 36 – 39, 41 – 43, 45 and 46 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,393,061 to Manship et al. ("Manship" herein). Applicants respectfully traverse this rejection for the reasons specified below.

Manship does not disclose the following claim features, as is discussed in detail below:

Claims 1, 36, 39, 45

- based on a parameter specified by a player, allocating the outcome amount among the total number of events

Claim 41

- based on a parameter specified by a player, allocating the outcome amount over at least one of: (i) time, and (ii) a representation of space

Claim 42

- based on a parameter specified by a player, allocating the total payout amount among the total number of lottery events

Claim 43

- allocating the outcome amount among a total number of events according to a method specified by the player

Manship discloses a video slot machine having multiple paylines. The “player can assign appropriate bets to any or all of the paylines” (col. 8, lines 65 – 66), thus selecting which paylines to activate for a given game play. The video slot machine screen is divided into nine cells, each cell capable of displaying a game element. Once the player spins the reels, a microprocessor of the video slot machine generates nine random numbers, each generated random number corresponding to a game element and being associated with one of the nine cells of the screen (col. 9, lines 8 – 21). Once the reels stop spinning, the microprocessor determines what game elements to display in each cell. The microprocessor then “examines the combinations of displayed game elements in the cells located along each pay-out line 36 on which the player has placed a bet and compares the displayed game elements with the combinations of game elements stored in the...pay-out table 60 to determine if a win has occurred...If a winning combination of game elements occurs, the microprocessor-based circuit calculates the credits won from each pay-out table and computes the total credits won during that game play.” (col. 9, lines 39 – 53). In other words, the slot machine determines a total pay-out amount to provide to the player by totaling the payout amounts corresponding to each payout line activated by the player.

Totaling individual payouts for individual payout lines in order to determine a sum payout does not anticipate the claimed feature(s) of allocating a total payout over a plurality of events (or time or space), much less of doing so based on a parameter or method specified by a player. In Manship, each individual payout for each individual payline is determined based on the random numbers generated for the nine cells comprising the payline combinations. The totaling of the payouts is effected by which paylines the player had activated at the beginning of the game play. However, there is no total payout or outcome amount that is *allocated* over a plurality of paylines or events in Manship.

In Manship the payouts for each individual payline activated by the player must necessarily be determined first in order to obtain a total payout amount. There is no disclosure in Manship of determining a total payout amount and then allocating it among the paylines, based on a parameter specified by the player or otherwise and Manship does not enable such a method since the total payout amount cannot be known until the payouts for the individual paylines are first determined. Once the payouts for the individual paylines are determined and totaled, allocating the total payout amount among the individual paylines would be superfluous since that information was already determined and the determining factor in obtaining the total payout amount for a game play.

The following discussion outlining an example may be helpful in illustrating some differences between the claimed embodiments and the embodiments of Manship:

Example:

Assume a player activates three (3) paylines on a Manship slot machine, payline A, payline B, and payline C. Further assume that, based on the game elements displayed along each payline, each game element having been determined based on a random number, payline A corresponds to a payout of \$5, payline B corresponds to a payout of \$10, and payline C corresponds to a payout of \$0.

According to the Manship method, the microprocessor determines the total payout due to the player at the end of the game play by totaling the individual payouts corresponding to each of the paylines activated by the player. Thus, in the present example, the microprocessor determines the total payout due to the player to be \$15 (\$5 + \$10 + \$0 = \$15). Note that the total payout due to the player can only be determined by first determining the individual payouts corresponding to the respective paylines activated by the player.

If Manship were to disclose the claimed embodiments, which it does not, the method of Manship would instead first determine a total payout or outcome amount and then allocate this total outcome amount over the plurality of paylines (based on a parameter specified by the player). For example, the microprocessor would first need to

determine an outcome amount for the game play (e.g., \$20) and then determine how to allocate this \$20 outcome amount over the paylines activated by the player. For example, the microprocessor may allocate the entire \$20 amount to one of three paylines activated by the player and \$0 to each of the remaining two paylines. However, this method would completely circumvent the teachings of Manship as to how a payout for a payline is determined: by first generating a random number for each cell of a payline, displaying the game element corresponding to the generated random number, and then evaluating the game elements displayed along the payline to determine whether the combination of game elements displayed along the payline matches any winning combination of game elements stored in a payout database.

As can be seen from the example, the method of the claimed embodiments for how a payout is determined for a plurality of events (by allocating an outcome amount among the events based on a parameter specified by the player) is completely different from how a payout is determined for a plurality of events in Manship (by determining whether the combination of game elements displayed along the payline, which were each determined based on a random number, corresponds to a payout in a payout database).

Claims 2 – 7, 9 – 10 and 12 – 30 are each dependent from claim 1. Claims 37 and 38 are each dependent from claim 36. Claim 44 is dependent from claim 43. Accordingly, Applicants respectfully submit that claims 2 – 7, 9 – 10, 12 – 30, 37, 38 and 44 are patentable at least for the same reasons as claims 1, 36 and 44.

2(b). Claims 1, 6, 8, 9, 11, 33, 34, 43 and 44

Claims 1, 6, 8, 9, 11, 33, 34, 43 and 44 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,871,398 to Schneier et al. (“Schneier” herein).

Pursuant to 37 C.F.R. 1.78(a), Applicants have amended the specification herein to claim priority to Application Serial No. 10/620,260, which (through a chain of continuation applications) claims priority to Schneier. Accordingly, Schneier no longer qualifies as prior art against the pending claims.

3. Section 103 Rejection of Claims

3(a). Claims 8 and 11

Claims **8 and 11** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Manship. Applicants respectfully traverse this rejection for the reasons specified below.

Claims **8 and 11** are each dependent from claim **1**. As argued above in section 2(a), claim **1** is patentable over Manship at least because Manship does not disclose the claimed feature of “based on a parameter specified by the player, allocating the outcome amount among the total number of events”. Since claims **8 and 11** are dependent from claim **1** and thus include all of the features of claim **1**, Applicants respectfully submit that claims **8 and 11** are patentable at least for the same reasons as claim **1**.

Official Notice

Applicants note that, in support of the 103 rejection of claims **8 and 11**, Examiner appears to be taking Official Notice that “it is notoriously well known within the art of gaming machines that credit cards or smart cards can be used to debit and credit based upon wagers and winning outcomes.” (current Office Action, page 7). Applicants are unsure as to how the facts Examiner has taken Official Notice of are relevant to the features of claim **8 and 11**. Claim **8** recites that “an indication of the parameter specified by the player” (claim **6**, from which claim **8** is dependent) may be received “via at least one of: (i) a communication network, (ii) the Internet, and (iii) a telephone network.” Claim **11** recites that “an indication of the outcome amount” (claim **9**, from which claim **11** is dependent) may be received “via at least one of (i) a communication network, (ii) the Internet, and (iii) a telephone network.” Neither claim **8** or claim **11** recite using credit cards or smart cards to debit or credit based upon winning wagers and winning outcomes. Accordingly, Applicants are unsure as to how adding credit card machines into the gaming device of Manship in order to provide convenience to a player results in the embodiments of claims **8 and 11**. Clarification is respectfully requested.

Further, even if a credit/debit card machine were incorporated into the gaming device of Manship, the result would still not render obvious the embodiments of claims **8 and**

11. This is because incorporating a debit/credit card machine into a gaming device still does not teach or suggest (i) receiving, via a communication network, Internet, or telephone network, an indication of a parameter from a player, based on which parameter an outcome amount is allocated among a total number of events (claim 8), or (ii) receiving, via a communication network, Internet, or telephone network, an indication of an outcome amount.

Motivation to Combine

Applicants respectfully submit that the statement provided as a reason why one of ordinary skill in the art would have modified Manship in the manner suggested does not qualify as a proper motivation to combine references and thus the primary burden of establishing a *prima facie* case of obviousness has not been met with respect to claims 8 and 11. It has been asserted, in support of the 103 rejection of claims 8 and 11, that “one would be motivated to provide the use of credit/smart cards in order to provide convenience for a player that does not want to carry money around. Therefore, it would have been obvious to one having ordinary skill in the art...to incorporate credit card machines into the gaming device of Manship *in order to provide convenience to a player.*” (Current Office Action, page 7, emphasis added). This motivation to combine (to provide convenience to a player) is a mere statement of a desirable result that may be achieved by modifying the reference and is thus improper because there is no basis in the record to support the modification.

When prior art references are combined or modified in support of a 103 obviousness rejection, the reason for the modification or combination must come from some teaching, suggestion, or implication in the prior art as a whole or in knowledge generally available to one having ordinary skill in the art. Applicants note, in emphasis, that the prior art or knowledge generally available to one of ordinary skill in the art must not only teach the claimed elements, but also the reason for making the combination or modification. In the present Application, Examiner appears to be asserting that each of the claimed elements is either taught or suggested by Manship or an allegedly well-known principle, but has not set forth any support from the record as to why one of ordinary skill in the art would have been motivated to make the asserted combinations or modifications in order to arrive at the

claimed embodiments. Bald statements of opinion from an examiner such as the ones provided in the current office action, which basically state that the motivation to combine is that desirable results will occur, are insufficient to meet Examiner's burden. See, for example, the following excerpt from a Board of Appeals opinion:

“The examiner's position can be stated basically to be that the modification of [the prior art reference] necessary to arrive at the claimed invention would have been obvious to the artisan because it would improve efficiency, performance, and reliability of the [prior art reference method]. While this result indicated by the examiner is undoubtedly correct, it is not a valid basis for the rejection of a claim. It explains more why appellant wishes to patent such a process. Since most inventions are designed to improve efficiency, performance or reliability, the examiner's analysis would make it very difficult to patent anything.” (Ex Parte Bowen, Appeal No. 96 – 1349).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01.

When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1352 (Fed. Cir. 2001). In each case the factual inquiry whether to combine references must be thorough and searching. Id., at 1352 - 53.

3(b). Claims 31 and 32

Claims **31 and 32** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Manship in view of U.S. Patent No. 5,564,700 to Celona (“Celona” herein). Applicants respectfully traverse this rejection for the reasons specified below.

Claims **31 and 32** are each dependent from claim 1. As argued above in section 2(a), Manship does not disclose the feature of “based on a parameter specified by the player,

allocating the outcome amount among the total number of events”. Celona also does not disclose this feature.

Motivation to Combine

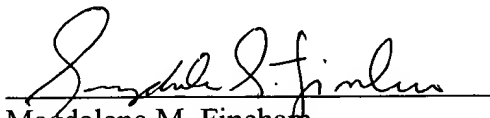
Applicants respectfully submit that the statement provided as a reason why one of ordinary skill in the art would have combined Manship with Celona in the manner suggested does not qualify as a proper motivation to combine references and thus the primary burden of establishing a *prima facie* case of obviousness has not been met with respect to claims 8 and 11. It has been asserted, in support of the 103 rejection of claims **31 and 32**, that “it would have been obvious to one having ordinary skill in the art....to incorporate re-allocating a payout into the game device of Manship *in order to provide additional winnings to players.*” (Current Office Action, page 8, emphasis added). This motivation to combine (to provide additional winnings to players) is a mere statement of a desirable result that may be achieved by modifying the reference and is thus improper for the same reasons as the motivation to modify Manship, provided in support of the 103 rejection of claims 8 and 11, is improper.

Petition for Extension of Time to Respond

Applicants hereby petition for a **one-month** extension of time with which to respond to the Office Action. Please charge \$55.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



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